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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,150	11/07/2000	Paul Kurth	Q040	1015

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02/04/2003

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EXAMINER

SERKE, CATHERINE

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No. 09/708,150	Applicant(s) KURTH, PAUL	
	Examiner Catherine Serke	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 1, 7, 13-28, 33-36, 42-52, 54, 57, 61-69, 76-89 and 92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-12, 29-31, 37, 38, 40, 55, 56, 58-60, 70 and 71 is/are rejected.
- 7) ☒ Claim(s) 32, 39, 41, 53, 72-75 and 90-91 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3763

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the species of figures 1a-1d in Paper No. 6 is acknowledged.

Claims 1, 13-28, 83-89 and 92 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Applicant has indicated that all the remaining claims are readable upon the species of figures 1a-1d. Upon review by the examiner, it has been determined that claims 7, 33-36, 42-52, 54, 57, 61-69 and 76-82 read on other species in the application. Therefore, claims 7, 33-36, 42-52, 54, 57, 61-69 and 76-82 have also been withdrawn from review.

Drawings

The corrected or substitute drawings were received on 11/6/02. These drawings are entered into the record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3763

Claims 2, 6, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Slater (US Pat# 5,395,341).

Slater discloses a catheter sheath introducer that includes a moldable sheath (see 3:26-32) with a lumen (22). The sheath has a sealing valve (14). This distal portion of the sheath is made from a different material that has both different stiffness and different moldability from the proximal portion. The sheath can be deployed in a body cavity. The distal portion of the sheath will have been altered before implantation into the body in order to have shape memory upon contact with the temperature of the body. Once inserted into the body the distal portion will change shape in reaction to the temperature of the body (see figures 2-3).

Claims 2-6, 8-12, 29-31, 37-38, 40, 55-56, 58-60 and 70-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Kratoska et al (US Pat# 6,090,072).

Kratoska discloses an expandable introducer sheath that includes a moldable sheath with a lumen and a shaping tool (mandrel) that is separate from the sheath but incorporated into the lumen of the sheath, see figure 2B. The sheath also has a sealing valve (62). As shown in figures 3B-3D, as the mandrel is introduced into the sheath the sheath will have different portions having different stiffness and moldability depending on how far into the sheath the mandrel has been advanced, see figure 3C. Since the sheath is moldable by the mandrel the sheath can be molded before, during or after the sheath is inserted into the body cavity. The sheath has a guidewire (64).

Art Unit: 3763

Allowable Subject Matter

Claims 32, 39, 41, 53, 72-75 and 90-91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine Serke *CS.*
January 27, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700